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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/652,864

08/29/2003

Heinz Kohler

IXS-10002/49

1487

25006

7590

03/20/2009

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EXAMINER

BLANCHARD, DAVID J

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/652,864	<b>Applicant(s)</b> KOHLER ET AL.	
	<b>Examiner</b> David J. Blanchard	<b>Art Unit</b> 1643	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 December 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. Claims 1-6 and 11-17 are cancelled.
2. Claims 7-10 are pending and under consideration.

### ***Rejections Maintained***

#### **Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. The rejection of claim 7 under 35 U.S.C. 103(a) as being unpatentable over Nakamura et al (Cancer Research, 54(6):1511-1516, 1994) in view of Kohler et al [a]

Art Unit: 1643

(U.S Patent 6,238,667, filed 5/4/1998, IDS reference filed 9/23/04) and Kang et al (Science, 240:1034-1036, 1988, IDS reference filed 11/7/05) is maintained.

The Declaration under 37 CFR 1.132 filed 16 December 2008 is insufficient to overcome the rejection of claim 7 based upon Kohler et al [a] as set forth in the last Office Action because the Declaration does not prove that the joint invention of the instant application (e.g., Kohler and Morgan) was made first, and there is no indication that the portions of the reference relied on disclosed anything Kohler and Morgan did jointly, nor is there any showing that what Kohler and Morgan did jointly was done before the filing of the reference patent ('667). The Kohler Declaration only declares that "any work relating to the present application which is disclosed in U.S. Patent 6,238,667 was my invention."

MPEP 2136.05 states:

In the situation where one application is first filed by inventor X and then a later application is filed by X & Y, it must be proven that the joint invention was made first, was thereafter described in the sole applicant's patent, or \*\* was thereafter described in the sole applicant's U.S. patent application publication or international application publication, and then the joint application was filed. In re Land, 368 F.2d 866, 151 USPQ 621 (CCPA 1966).

In In re Land, separate U.S. patents to Rogers and to Land were used to reject a joint application to Rogers and Land under 35 U.S.C. 102(e) /103. The inventors worked for the same company (Polaroid) and in the same laboratory. All the patents flowed from the same research. In addition, the patent applications were prepared by the same attorneys, were interrelated and contained cross-references to each other. The court affirmed the rejection because (1) the inventive entities of the patents (one to Rogers and one to Land) were different from the inventive entity of the joint application (Rogers and Land) and (2) Land and Rogers brought their knowledge of their individual work with them when they made the joint invention. There was no indication that the portions of the references relied on disclosed anything they did jointly. Neither was there any showing that what they did jointly was done before the filing of the reference patent applications.

Additionally, it is noted that subject matter relied upon in the instant rejection is claimed subject matter in the Kohler et al [a] reference (e.g., see double patenting rejection below). Applicant is reminded that a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor(s) of this application and is thus not an invention "by another". Further, it is noted that the issue date of the Kohler et al [a] reference is more than one year before the effective filing date of the instant application.

Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references and the rejection is maintained.

5. The rejection of claims 8-10 under 35 U.S.C. 103(a) as being unpatentable over Nakamura et al (Cancer Research, 54(6):1511-1516, 1994) in view of Kohler et al [b] (US 2003/0103984 A1, filed 5/29/2001, IDS reference filed 9/23/04) and Kang et al (Science, 240:1034-1036, 1988, IDS reference filed 11/7/05) and Zhao et al (J. Immunol. Methods, 254(1-2):137-145, August 1, 2001, IDS reference filed 11/7/05) and Singh et al (U.S. Patent 7,041,459; filed 5/21/2002, cited on PTO-892 mailed 5/125/07) is maintained.

The Declaration under 37 CFR 1.132 filed 16 December 2008 is insufficient to overcome the rejection of claims 8-10 based upon Kohler et al [b] as set forth in the last Office action because the Declaration does not prove that the joint invention of the instant application (e.g., Kohler and Morgan) and was made first, and there is no indication that the portions of the reference relied on (US 2003/0103984 A1) disclosed anything Kohler and Morgan did jointly, nor is there any showing that what Kohler and Morgan did jointly was done before the filing of the reference patent application(US 2003/0103984 A1). The Kohler Declaration only declares that "any work relating to the present application which is disclosed in U.S. Patent Application No. 2003/0103984 was my invention."

MPEP 2136.05 states:

In the situation where one application is first filed by inventor X and then a later application is filed by X & Y, it must be proven that the joint invention was made first, was thereafter described in the sole applicant's patent, or \*\* was thereafter described in the sole applicant's U.S. patent application publication or international application publication, and then the joint application was filed. In re Land, 368 F.2d 866, 151 USPQ 621 (CCPA 1966).

In In re Land, separate U.S. patents to Rogers and to Land were used to reject a joint application to Rogers and Land under 35 U.S.C. 102(e) /103. The inventors worked for the same company (Polaroid) and in the same laboratory. All the patents flowed from the same research. In addition, the patent applications were prepared by the same attorneys, were interrelated and contained cross-references to each other. The court affirmed the rejection because (1) the inventive entities of the patents (one to Rogers and one to

Art Unit: 1643

Land) were different from the inventive entity of the joint application (Rogers and Land) and (2) Land and Rogers brought their knowledge of their individual work with them when they made the joint invention. There was no indication that the portions of the references relied on disclosed anything they did jointly. Neither was there any showing that what they did jointly was done before the filing of the reference patent applications.

Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references and the rejection is maintained.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. The rejection of claims 7-10 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 7, 10-11 and 17 of U.S. Patent No. 6,238,667 B1 in view of Nakamura et al (Cancer Research, 54(6):1511-1516, 1994) and Kohler et al [b] (US 2003/0103984 A1, filed 5/29/2001, IDS reference filed 9/23/04) and Kang et al (Science, 240:1034-1036, 1988, IDS reference filed 11/7/05) and Zhao

Art Unit: 1643

et al (J. Immunol. Methods, 254(1-2):137-145, August 1, 2001, IDS reference filed 11/7/05) and Singh et al (U.S. Patent 7,041,459, filed 5/21/2002, cited on PTO-892 mailed 5/125/07) is maintained.

The response filed 12/26/2008 states that Applicant is willing to submit a terminal disclaimer, if appropriate, in the case that conflicting claims are allowed in the present case. Applicants' remarks are acknowledged, however, in view that the instantly claimed subject matter is patentably indistinct from claims 1-3, 7, 10-11 and 17 of U.S. Patent No. 6,238,667 B1 as set forth in the previous Office Action and in view that no terminal disclaimer has been filed, the rejection is maintained.

8. No claim is allowed.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Blanchard whose telephone number is (571) 272-0827. The examiner can normally be reached at Monday through Friday from 8:00 AM to 6:00 PM, with alternate Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms, can be reached at (571) 272-0832.

Art Unit: 1643

The official fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David J. Blanchard/  
Primary Examiner, A.U. 1643